

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of	:	Customer No. 26817
VEGLIANTE et al.	:	
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**BRIEF ON APPEAL**

## TABLE OF CONTENTS

	<u>Page</u>
I. REAL PARTY IN INTEREST .....	1
II. RELATED APPEALS AND INTERFERENCES .....	2
III. STATUS OF CLAIMS .....	3
IV. STATUS OF AMENDMENTS .....	4
V. SUMMARY OF CLAIMED SUBJECT MATTER .....	5
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL .....	12
VII. ARGUMENT .....	13
VIII. CLAIMS APPENDIX.....	56
IX. EVIDENCE APPENDIX.....	61
X. RELATED PROCEEDINGS APPENDIX .....	62

I. REAL PARTY IN INTEREST

The real party in interest of the above-captioned Application is the assignee, AEP Industries, Inc.

II. RELATED APPEALS AND INTERFERENCES

There is one appeal related to the instant Appeal. United States Patent Application Serial No. 09/741,521 filed December 20, 2001, entitled Film Cutter Assembly, is the parent case of this continuation-in-part application. A Notice of Appeal in Serial No. 09/741,521, appealing the Examiner's Office Action mailed January 21, 2010, was filed on February 18, 2010, and the Appeal Brief is being filed on even date herewith. No appeal number has been assigned yet. Except for the Appeal in Serial No. 09/741,521, there are no other appeals, interferences, or judicial proceedings known to appellants that will have a bearing on the Board's decision in the present Appeal.

III. STATUS OF CLAIMS

Claims 1-39, were filed with the original Application. Claims 40-44 were added during prosecution.

Claims 2-4, 6-10, 15, 24-37, and 41 have been canceled. Claims 1, 5, 11-14, 16-23, 38-40 and 42-44 remain pending in this Application. All of the remaining claims stand rejected and are the subject of this Appeal. No claims in the Application have been allowed. The claims are reproduced in the CLAIMS APPENDIX.

IV. STATUS OF AMENDMENTS

The Amendment filed September 17, 2004 in response to the Final Office Action mailed April 20, 2004 was not entered as set forth in the Advisory Action mailed October 15, 2004. The Amendment filed April 2, 2007 in response to the Final Office Action mailed December 8, 2006 was not entered as set forth in the Advisory Action mailed May 1, 2007.

No amendments were filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants' claimed invention, set forth in independent claim 1, is directed to a film cutter apparatus for cutting plastic wrap with an elongated rail base, at least one rail at the top surface of the base, a blade housing that houses a blade that is slidable along the rail and a blade that is angled from a bottom edge of the blade. (specification, page 2, lines 28-31, page 7, lines 13-20, Figure 1, nos. 10, 11, 12, 14, 16, 18, 19, 26 and Figure 6, nos. 22, 36, 37, 38). An upper portion of the rail is formed of a material which provides cling properties to the plastic wrap when it is received over the rail for attracting the plastic wrap to the rail and holding the plastic wrap to the rail before, during and after cutting of the plastic wrap. (specification page 5, lines 9-27, Figure 1, nos. 13, 14, 17). The material forming the rail is selected from the group consisting of, rubber, polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof, and the elongated rail base is formed of a second material of rigid PVC. The rail and the elongated rail base materials are co-extruded with each other. (specification page 5, lines 5-34, Figure 1, nos. 12, 13, 14, 17).

In another embodiment of the claimed invention, as is set forth in dependent claim 5, which depends from claim 1, comprises the plastic film cutter of independent claim 1 wherein the first material is smooth. (specification page 5, lines 15-16).

A further embodiment of the claimed invention, as is set forth in claim 11, which depends from claim 1, comprises the plastic film cutter of independent claim 1 wherein a channel is formed in the elongated rail base below a pair of rails, and the blade housing is formed of an upper portion and a lower portion, the upper portion of the blade housing houses

the blade, and the lower portion of the blade housing slidably moves in the channel.

(specification page 6, lines 5-24, Figure 1, nos. 11, 14, 18, 19, Figure 2, nos. 18, 19, 20, 21.)

In still another embodiment of the claimed invention, as is set forth in dependent claim 12, which depends from claim 11, comprises the apparatus of claim 11 wherein a bottom edge of the upper portion of the blade housing protrudes on either end from the blade and an end surface of the upper portion of the blade housing is rounded and inclined upwardly and from either end of said bottom edge. (specification page 6, lines 9-17, Figure 2, nos. 18, 19, 22, 23, 24, 25, Figure 3, nos. 18, 19, 22, 23, 24, d1.)

In another embodiment of the claimed invention, as is set forth in dependent claim 13, which depends from claim 11, comprises the apparatus of claim 11 wherein the lower portion of the housing is formed of a tracking device for slidably moving in the channel. (specification page 6, line 30 – page 7, line 6, Figure 3, nos. 11, 18, 20, 29.)

A further embodiment of the claimed invention, as is set forth in dependent claim 14, which depends from claim 13, comprises the apparatus of claim 13 wherein the tracking device is formed of a tubular base and the channel has a corresponding tubular shape. (specification page 6, lines 32-33, Figure 5, nos. 11 and 29.)

Another embodiment of the claimed invention, as is set forth in claim 16, which depends from claim 1, comprises the apparatus of claim 1 wherein the blade housing is formed of acetal or silicon. (specification page 6, lines 19-21.)

A further embodiment of the claimed invention, as is set forth in claim 17, which depends from claim 1, comprises the apparatus of claim 1 and further comprises an adhesive



layer adhered to the elongated rail base on a surface opposite the rail. (specification page 8, lines 5-18, Figure 7C, nos. 13, 14, 100, 104, 105.)

A still further embodiment of the claimed invention, as is set forth in claim 18, which depends from claim 1, comprises the apparatus of claim 1 wherein a channel is formed in the elongated rail base below a pair of rails, and further comprises a protrusion extending in said channel at either end of the channel. (specification page 8, lines 25-35, Figure 8, nos. 11, 120, 122, 123, 125.)

Another embodiment of the claimed invention, as is set forth in claim 19, which depends from claim 18, comprises the apparatus of claim 18 wherein the blade housing is formed of an upper portion and a lower portion, the upper portion houses the blade, the lower portion of the housing slidably moves in the channel and snap fits into the protrusion. (specification page 6, lines 5-33, page 8, lines 30-35, Figure 3, nos. 11, 18, 20, 21, Figure 8, nos. 11, 18, 120, 122, 123, 128, 130.)

Still another embodiment of the claimed invention, as is set forth in independent claim 20, comprises a film cutting apparatus for cutting plastic wrap comprising, at least one rail, a blade housing for housing a blade and which is bilaterally slidable along the rail, and a blade angled from its bottom edge of said blade. (specification page 4, lines 27-34, page 6, lines 5-8, page 6, lines 30-32, page 7, lines 13-20, Figures 1 and 2, nos. 11 - 14, 16, 18, 19, Figure 6, nos. 22, 36, 37, 38.) In addition, a portion of the rail is formed of a material which provides an attractive cling to plastic wrap received over the rail for attracting plastic wrap to it and clinging the plastic wrap to the rail before, during and after cutting of said plastic wrap. The material is selected from the group consisting of plastic, rubber, polyvinyl chloride, said polyvinyl chloride

comprising at least 10% plasticizer, silicon elastimer and combinations thereof. (specification page 5, lines 9-27.)

Another embodiment of the claimed invention, as is set forth in independent claim 21, comprises a film cutter apparatus for cutting plastic wrap comprising at least one rail, a blade housing for housing a blade, and which housing is bilaterally slidable along the rail, and the blade is angled from its bottom edge. (specification page 4, lines 27-30, page 6, lines 5-8, page 6, lines 30-32, page 7, lines 13-20, Figures 1 and 2, nos. 11 -14, 16, 18, 19, Figure 6, nos. 22, 36, 37, 38.) In addition, a portion of the rail is formed of a first material which provides cling properties to plastic wrap received over the rail for attracting said plastic wrap to the rail and for holding the plastic wrap to the rail before, during and after cutting of the plastic wrap. (specification page 5, lines 9-11 and lines 24-27.) Moreover, an adhesive layer is adhered to the elongated rail base on a surface opposite of the rail (specification page 8, lines 5-8, Figure 1, nos. 12, 14, 16, Figure 7C, nos. 13, 14, 100, 104, 105.) Also, the first material is selected from the group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof. (specification page 5, lines 19-27.)

Another embodiment of the claimed invention, as is set forth in independent claim 22, comprises a film cutter apparatus for cutting plastic wrap comprising an elongated rail base, a pair of rails at a top surface of the rail base, a blade housing for housing a blade, and which is bilaterally slidable along said rails. Also the blade is angled from its bottom edge. (specification page 4, lines 27-30, page 6, lines 5-8, page 6, lines 30-32, page 7, lines 13-20, Figures 1 and 2, nos. 11-14, 16, 18, 19, Figure 6, nos. 22, 36, 37, 38.) In addition, a portion of the rails is formed of a first material which provides cling properties to plastic wrap received over the rails for

attracting said plastic wrap to the rails and for holding said plastic wrap to the rails before, during and after cutting of the plastic wrap. (specification page 5, lines 9-27.) In addition, the first material is selected from the group consisting of plastic, rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof, and the elongated rail base is formed of a second material of rigid PVC, and the first and second materials are coextruded. (specification page 4, line 27 – page 5, line 31.)

Another embodiment of the claimed invention, as is set forth in independent claim 23, comprises a film cutter apparatus for cutting plastic wrap comprising an elongated rail base with a pair of rails formed at a top surface of the rail base. (specification page 4, lines 27-34, Figures 1 and 2, nos. 11-14, 16.) A portion of the rails is formed of a first material which provides cling properties to plastic wrap received over the rails for attracting plastic wrap to said rails and for holding the plastic wrap to the rails before, during and after cutting the plastic wrap. (specification page 5, lines 9-27.) In addition, the first material is selected from the group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof. (specification page 5, lines 16-27.) Also, the apparatus has a blade housing for housing a blade, and which is bilaterally slidable along the rails. The blade housing is formed of upper and lower portions. The upper portion of the blade housing houses a blade, and the lower portion of the blade housing slidably moves in the channel. In addition, the blade is angled from its bottom edge of said blade. (specification page 6, lines 5-17, and 30-32, page 7, lines 13-20, Figures 1 and 2, nos. 11, 14, 16, 18, 19, 20, 23, 24, 25, Figure 3, nos. 11, 12, 18 - 25, 29, Figure 6, nos. 22, 36, 37, 38.) Moreover, the elongated

rail base is formed of a second material of rigid PVC, and the first material is coextruded with said second material. (specification page 5, lines 5-8 and 28-29.)

Another embodiment of the claimed invention, as is set forth in independent claim 38, comprises a method of forming a film cutter apparatus comprising, molding an elongated rail base and a pair of rails, attaching the rails at a top surface of the elongated rail base, wherein a portion of the rails are formed of a material having cling properties for attracting film to the rails and for holding the film to the rails before, during and after cutting of said film. (specification page 4, line 27 - page 5, line 34, Figures 1 and 2, nos. 11-14, 16, 17.)

Still another embodiment of the claimed invention, as set forth in dependent claim 39, which depends from claim 38, comprises the method of claim 38 wherein the steps of molding an elongated rail base and a pair of rails are performed simultaneously by co-extrusion so as to attach the rails to the rail base. (specification page 4, lines 27-31, page 5, lines 28-29.)

Another embodiment of the claimed invention, as is set forth in independent claim 40, comprises a method for cutting a plastic wrap comprising, an elongated rail base, receiving the plastic wrap over at least one rail formed at a top surface of the rail base and clinging the plastic wrap to a rail. (specification page 4, line 27 - page 5, line 27, Figures 1 and 2, nos. 12, 13, 14, 16, 17.) In addition, the rail is formed of a material which provides cling properties to the received plastic wrap for the clinging of the plastic wrap to the rails. (specification page 5, lines 9-27.) Moreover, the method provides for the cutting of the plastic wrap with a blade that is housed in a blade housing, and the blade housing is bilaterally slidable along the rail, and wherein the plastic wrap clings to the rail before, during and after cutting of the plastic wrap.

(specification page 5, lines 9-11, page 6, lines 5-8, page 6, line 30 – page 7, line 6, Figures 1 and 2, nos. 11 - 14, 16, 18, 19 , 20 - 25, Figure 3, nos. 11, 18, 20, 21, 22, 29.)

Still another embodiment of the claimed invention, as is set forth in dependent claim 42, which depends from claim 40, comprises the method for cutting a plastic wrap of claim 40 wherein the first material is non-porous. (specification page 5, lines 14-15.)

Another embodiment of the claimed invention, as is set forth in dependent claim 43, which depends from claim 40, comprises the method for cutting a plastic wrap of claim 40 wherein the first material is smooth. (specification page 5, lines 15-16.)

Another embodiment of the claimed invention, as is set forth in dependent claim 44, which depends from claim 40, comprises the method for cutting a plastic wrap of claim 40 wherein the first material is selected from the group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof. (specification page 5, lines 19-27.)

VI. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 5, 11-14, 17, 20-23, 40, 42, 43, and 44 are obvious under 35 U.S.C. § 103(a) over U.S. Patent 5,440,961 to Lucas ("**Lucas**"), in view of U.S. Patent 3,549,066 to Wankow ("**Wankow**"), with supporting evidence from U.S. Patent 5,524,515 to Boda ("**Boda**"), U.S. Patent 4,210,043 to Urion ("**Urion**"), and U.S. Patent 5,036,740 to Tsai ("**Tsai**").

Whether claims 1, 5, 11-14, 20-23, 38-40, 42-44 are obvious under 35 U.S.C. § 103(a) over U.S. Patent 4,960,022 to Chuang ("**Chuang**"), an artifact submitted by a third party on 8/25/2008 in co-pending case 09/741,521, entered into the record as "**09741521MA**", in view **Lucas**, in view of **Wankow**, "Phthalate Ester Plasticizers-Why and How They Are Used" ("**Phthalate Reference**," EVIDENCE APPENDIX, Ex. 1), and U.S. Patent 4,856,975 to Gearhart ("**Gearhart**").

Whether claims 1 and 16 are obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** and further in view of **Urion**.

Whether claim 17 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart** as applied to claims 1, 5, 11-14, 20-23, 38-40, 42-44, and further in view of U.S. patent 5,398,576 to Chiu ("**Chiu**").

Whether claims 18 and 19 are obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart**, and further in view of U.S. Patent 3,277,760 to Keene ("**Keane**").

VII. ARGUMENT

As is set forth in the arguments below, all of the claims on appeal should be declared allowable and patentable over 35 U.S.C. § 103(a).

1. Claim 1 Should Be Declared Allowable

In summary form, independent claim 1 is directed to a film cutter for cutting plastic wrap comprising an elongated base, at least one rail formed at the top surface of the rail base, a blade housing for housing a blade, and which is bilaterally slidable along the rail. The blade is angled from a bottom edge of the blade. At least a portion of the rail is made of a first material that provides cling properties to the plastic wrap received over the rail for attracting the wrap to the rail before, during and after the cutting of the wrap. The first material of the rail is selected from the group consisting of rubber, PVC, wherein the PVC comprises at least 10 percent plasticizer, silicon elastimer and combinations thereof, and the rail base is made of a second material containing rigid PVC. The first and second materials are co-extruded.

A. Rejection of Claim 1 at Page 3, ¶ 4 of the Action

In the Action mailed January 21, 2010 (hereinafter, the “Action”), it is said at page 3, ¶ 4, that claim 1 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsal** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

The primary basis for this rejection is the combination of **Lucas** and **Wankow**. As an initial matter, there is simply no teaching, suggestion or motivation to combine **Lucas** and

**Wankow** to arrive at the invention of claim 1, or, in particular, to modify **Lucas** in view of **Wankow**.

**Wankow** discloses an ordinary box carton containing material wrapped around a roll and having on the lower front edge of the carton a fixed saw blade for cutting the material as it is pulled out of the carton. See Wankow Figures 1 and 2. **Lucas** is a more complex film cutter with a movable blade assembly that includes a roller/blade/housing system that rolls along a rail. See Lucas, Col. 3, lines 25-47; Figures 2 and 3. To cut film with **Lucas**, one must roll the blade across the film. To cut film with **Wankow**, one must tear the film across a fixed blade. Thus, the two devices are entirely different, and approach film cutting from two different and opposite directions, and, on their face, do not merit combination.

While **Wankow** does disclose vinyl dots for preventing the material from retracting into the box during use, see Col. 2, lines 46-52, the dots are not used to hold film down on top of a rail cutting surface. Moreover, **Wankow** does not teach, suggest or motivate the ordinary skilled worker to modify **Lucas** to include **Wankow's** vinyl dots on top of rails used in conjunction with the more complex rolling slide cutter disclosed in **Lucas**. Indeed, **Lucas** and **Wankow** are so unlike in structure and function that it is only through hindsight that one could combine them. Thus, neither reference points toward the other. In addition, There is no teaching, suggestion or motivation contained within these references to pick and choose one element of **Wankow** (vinyl spots) out of all the other elements of that box-carton reference to modify **Lucas**.

Moreover, even if, arguendo, **Lucas** and **Wankow** can be properly combined, such combination would still fall short of making out a case of the obviousness of claim 1. As



acknowledged in the Action, at page 7, **Lucas**, does not teach the attractive material of the present invention of polyvinyl chloride comprising at least 10% plasticizer. Rather, it is said that **Lucas** suggests the use of a urethane tape or coating. See Action, pages 6-7.

It is further important to note that the invention defined by the present claim is directed to a unified rail of PVC/10% plasticizer rails and rigid PVC rail base formed by co-extrusion of the rail and rail base materials, as opposed to the placement of a tape or coating on top of a rail. The cited art, either alone or in combination, does not disclose a film cutter comprised of an integrated rail/rail base assembly formed by co-extrusion as set forth in claim 1, and, the Action cites no such art.

Further, neither **Lucas** nor **Wankow** teach or suggest a rail formed of a material for providing attraction to plastic wrap received over a rail for clinging the plastic wrap to the rail “before, during and after cutting.” There is no teaching or suggestion in **Wankow** to modify a rail cutter to integrate plasticizer that provides cling attraction to the film to be cut. In **Lucas**, a non-slip surface formed of urethane tape is said to be adhered a surface of a single guide. See Col 3, lines 1-7. Specifically, however, in **Wankow**, there is no teaching or suggestion of modifying **Lucas** to form a rail, integrated with a rigid rail base by co-extrusion, that provides cohesion with a film. The claimed integrated rail base and plasticized rail is nowhere disclosed or suggested.

Thus, **Lucas** in view of **Wankow** do not teach a rail/rail base uniform structure having one material for providing cling properties for adhering the film to be cut, and another that provides durability properties, which materials are coextruded to form one integrated rail assembly. Moreover, the present invention has the advantage wherein the rail continuously

has the property of co- adhering to film “before, during and after” cutting of the film, to the cutter apparatus during use and for the lifetime of the film cutter apparatus. Urethane tape or vinyl spots adhered to a surface of a piece or carton box can lose adherence and can be removed from the piece or the box during continuous use over time. Thus, applicants submit that there is no reason that would have prompted one of ordinary skill in the art to combine the vinyl spots adhered to the side of a carton dispenser box of **Wankow** to adherence of the vinyl spots on a rail. And, even if the references were combined, the combination does not teach a uniform cohesive rail/rigid rail base structure formed by coextrusion, not simply adherence of a tape to the rail.

The allegedly supporting references, **Boda**, **Urion**, and **Tsai**, do not support the combination of **Lucas** in view of **Wankow**.

**Boda** teaches a paper cutter assembly including a unitary base and rail arranged at right angles to each other. The rail assembly is in the form of a right angle extrusion. The angular construction provides a rigid structure throughout its length. See Col. 2, lines 46-61; Figures 1 and 2. However, **Boda** does not teach or suggest co-extrusion to form an adhesive rail material which provides cohesion to a plastic wrap integrated with a base of a rigid material for durability. Further, **Boda** does not teach or suggest co-extrusion of a material of polyvinyl chloride having at least 10% plasticizer and a material of rigid PVC. The selection and combination of the materials in the invention of claim 1 have the advantages of providing a material for a rail having cling properties and a material for a rail base having durability properties. There is no teaching or suggestion of these structures and advantages in **Boda**.

At page 4 of the July 3, 2007 Action, incorporated in this rejection, it is stated that co-extrusion is well known in the manufacturing of polymers and “does not further limit the structure,” pointing to **Boda** and **Lucas**. Applicants, however, respectfully submit that this is a red herring argument. Neither **Boda** nor **Lucas** disclose a co-extruded film cutter rail structure. All that this portion of the July 3, 2007 Action stands for is that co-extrusion, as a general manufacturing process, can be applied in numerous contexts and does nothing to advance the disclosures or teachings of the relevant rail-based film cutter art with which this claim is specifically concerned.

**Urion** teaches a cutting assembly by injection molding of side segments and upper wall segments at an angle relative to the position of the completed article. See Col. 3, lines 14-26, Figure 2. However, **Urion** does not teach or suggest co-extrusion to form a rail of a material which provides cohesion to a plastic wrap and a base of a rigid material. Rather, **Urion** is directed to injection molding which is unrelated to the co-extruded structure of the present invention.

**Tsai** teaches a roller pressed film cutter apparatus. Four rollers are rotatably moving in a track. Film is pulled across the track and upon pushing of the slide holder the rollers will press and tension the film against the track. See Col. 1, lines 30-36, Figures 1-4. In contrast to the invention defined by present claim 1, **Tsai** does not teach or suggest one or more rails being formed of a material providing an attraction to film received over the rails to cling the plastic wrap before, during and after cutting of the plastic wrap.

### **B. Rejection of Claim 1 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 1 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

First, in this rejection, it is submitted, and as is explained below, that the asserted combination of these six references to reject claim 1 is untenable. Applicants respectfully submit that, on an objective basis, this complex combination of the prior art, including art outside the field of the instant invention, can only be made with the benefit of impermissible hindsight and the picking and choosing of claim elements from multiple and disparate art.

The primary reference, **Chuang**, discloses a slidable plastic film cutter with a push button having rollers disposed upon the bottom surface of the push button cutting means. The push button/roller combination is said to inhibit the plastic film from gathering at the bottom of the cutter blade because the film is pressed and pulled tightly during the cutting operation. See **Chuang**, Col. 2, lines 1-14; Figures 3C and 3D.

First, in contrast to the invention defined by the present claims, **Chuang** does not teach or suggest that the rails are formed of a material of polyvinyl chloride comprising at least 10% plasticizer which provides cohesion to the film received over the rails for clinging the film to the rails before, during and after cutting by the sliding blade housing within a channel. Rather, **Chuang** teaches using a roller means for keeping plastic wrap in a tensioned state. During prosecution of the instant application, Applicants showed the Examiner during an interview,

using the artifact (“09741521MA”) that was modeled after **Chuang**, that **Chuang** does not provide any attraction of the plastic wrap to the rails; the plastic wrap is only held in a tensioned shape by the rollers of the Chuang cutter. Thus, there is no teaching or suggestion in **Chuang** of the use of a material to provide cohesion of plastic wrap to rails of a slide cutter device.

Second, there is no objective evidence to make a non-hindsight combination of **Chuang**, **Lucas** and **Wankow**. Indeed, the Action, at page 6, acknowledges that “neither **Chuang** nor **Lucas** discloses ‘polyvinyl chloride comprising at least 10% plasticizer.’” Moreover, as stated above, **Wankow** is an ordinary wrapper carton with a fixed saw blade. **Chuang** is a much more complex film cutter with a movable roller blade assembly. To cut film with **Chuang**, as with **Lucas**, one must move the blade across the film; to cut film with **Wankow**, one must tear the film across the fixed blade. In addition, while the Examiner may believe that there is something functioning on the artifact to attract or adhere film, the objective evidence is that the reference **Chuang**, as opposed to an artifact that may have been made at any point in time, does not teach, suggest, motivate or disclose the use of an adhesive rail component made of at least 10 percent plasticizer on top of the rails of **Chuang** on the basis of **Lucas** and/or **Wankow**. In sum, **Chuang**, **Lucas** and **Wankow**, were trying to solve the problem of maintaining some stability of the material from different directions: **Chuang** (roller assembly), **Lucas** (possibly friction or tape) and **Wankow** (vinyl spot).

Third, it is further important to note that the invention defined by the present claim is directed to a unified rail of PVC/10% plasticizer rails and rigid PVC rail base formed by co-extrusion of the rail and rail base materials -- not the placement of rollers, a tape or coating on

top of a rail. The cited art, either alone or in combination, does not disclose the integrated rail/rail base assembly form by co-extrusion as set forth in claim 1, and, the Action points to no art that discloses or suggests the integrated rail/rail base assembly form by co-extrusion as described in this claim.

Fourth, this rejection is based upon an expanded combination that adds the **Phthalate Reference** and **Gearhart**. See Action, pages 7-8. However, the **Phthalate Reference** does not teach or suggest the use of phthalate ester plasticizers on cutting rails, it merely discusses the use of such plasticizers generally. See Ex. 1, page 1 of 1. Similarly, **Gearhart** generally teaches co-extrusion of PVC to bond a capstock material and is not directed to the film cutting art. See Col. 1, line 54-Col. 2, line 33.

In sum, there is no evidence supporting the combination of references in this rejection. In particular, there is absolutely no evidence that the skilled worker would reach out to the **Phthalate Reference** and **Gearhart**, which are in no way directed to cutting devices, and combine them with **Chuang**, the artifact **09741521MA**, **Lucas** and **Wankow**.

It is respectfully submitted that the combination of references in this rejection has been incorrectly made with reference to the claimed invention as a guide. Therefore, it is respectfully submitted that this rejection be reversed.

**C. Rejection of Claim 1 at Pages 9-10, ¶ 6 of the Action**

Further, in the Action, at pages 9-10, ¶ 6, it is said that claim 1 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** and further in view of **Urion**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

Applicants submit herein, the explanations set forth above with respect to the combination of **Chuang** with **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart**. In sum, applicants submit that there is no objective evidence to make a non-hindsight combination of **Chuang** (the roller assembly apparatus), **Lucas** (the possibly friction-based or tape attraction device) and **Wankow** (the box-carton device). Further, as detailed above, the **Phthalate Reference** does not teach or suggest the use of phthalate ester plasticizers on cutting rails, it merely discusses the use of such plasticizers generally, and, similarly, **Gearhart** generally teaches co-extrusion of PVC to bond a capstock material and is not directed to the film cutting art. The Action cites no prior art wherein an integrated multi-material film cutter is constructed by the co-extrusion of a rigid rail base/cohesive rail made from different compositions.

Further, adding **Urien** to the mix does not advance the argument of unpatentability. As stated above, **Urien** teaches a cutting assembly by injection molding, not co-extrusion, of side segments and upper wall segments at an angle relative to the position of the completed article. **Urien** does not teach or suggest a co-extruded, integrated assembly of a rail of a material which provides cohesion to a plastic wrap, and a base of a rigid material. Accordingly, the invention defined by claim 1 is not obvious over **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart** and further combined with **Urien**.

Finally, with respect to the rejections addressed above with respect to independent claim 1 (and the claims dependent therefrom, as discussed below), it should be noted that the claimed invention provides for, inter alia, clinging said plastic wrap to rails before, during and after cutting of said plastic wrap by the sliding of the blade housing between or along the rails. This feature of the invention results from the fact that the rails are formed of poly vinyl chloride

“with at least 10 percent plasticizer,” which, in turn, results in providing a “cohesive” attraction between the rails and the film, as opposed to a “friction” or “adhesive” attraction provided by the prior art. See Supp. Vegliante Decl., pages 1-2, ¶¶ 2-3. (Exhibit 3)

For the above reasons, claim 1 should be declared allowable.

**2. Claim 5 Should Be Declared Allowable**

Claim 5 depends from claim 1 and further recites the additional element wherein the first material forming the rail is smooth.

**A. Rejection of Claim 5 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 5 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit herein, the arguments and explanations set forth above regarding this rejection and claim 1 with respect to the combination of **Lucas** and **Wankow** with support from **Boda**, **Urion** and **Tsai**. In sum, as stated above with respect to claim 1, applicants submit that there is no objective evidence to make a non-hindsight combination of **Lucas** and **Wankow** and that **Boda**, **Urion** and **Tsai** do not support the rejection. Further it is submitted that the additional element wherein the first rail material comprised of, inter alia, PVC with 10% plasticizer is also smooth, and yet provides cling properties, further renders the invention patentable over the cited art.



**B. Rejection of Claim 5 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 5 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “**09741521MA**”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit herein the arguments and explanations set forth above regarding this rejection and claim 1 with respect to the combination of **Chuang**, the artifact (**0974152MA**) in view of **Lucas**, **Wankow**, the **Phthalate Reference** and **Gearhart**. Further, it is submitted that the additional elements wherein the first rail material comprised of, inter alia, PVC with 10% plasticizer is also smooth, and yet provides cling properties, further renders the invention patentable over the cited art.

For the above reasons, claim 5 should be declared allowable.

**3. Claim 11 Should Be Declared Allowable**

Claim 11 depends from claim 1 with the further element wherein a channel is formed in the elongated rail base below a pair of rails, and the blade housing is formed of an upper portion and a lower portion, and the upper portion of the housing houses a blade and the lower portion of the housing slides in the channel.

**A. Rejection of Claim 11 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 11 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set

forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claim 1. In addition, there is no teaching or suggestion in any of these references of the invention of claim 1, including the feature of a co-extruded rail base/rail material made of, inter alia, PVC with 10% plasticizer, and additionally claiming the film cutter of claim 11 having the aforementioned rail channel, upper and lower portion blade housing that slides in the channel formed between the rails. It is further submitted that these additional elements of claim 11 render the invention patentable over the cited art.

**B. Rejection of Claim 11 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 11 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “**09741521MA**”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claim 1. In addition, there is no teaching or suggestion in any of these references of the invention of claim 1, including the feature of a co-extruded rail base/rail material made of, inter alia, PVC with 10% plasticizer, and additionally claiming the film cutter of claim 11 having the aforementioned rail channel, upper and lower portion blade housing that slides in the channel formed between the rails. It is

further submitted that these additional elements of claim 11 render the invention patentable over the prior art.

For the above reasons, claim 11 should be declared allowable.

**4. Claim 12 Should Be Declared Allowable**

Claim 12 depends from claim 11 with the further element wherein a bottom edge of the upper portion of the blade housing protrudes on either end from the blade and an end surface of the upper portion is rounded and inclined upwardly and from either end of the bottom edge.

**A. Rejection of Claim 12 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 12 is obvious under 35 U.S.C. § 103(a) over Lucas, in view of Wankow, with supporting evidence from Boda, Urion, and Tsai as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claims 1 and 11. In addition, there is no teaching or suggestion in any of these references of the invention of claim 1, including the feature of a co-extruded rail base/rail material made of, inter alia, PVC with 10% plasticizer, and additionally claiming the film cutter of claim 12 having the aforementioned blade housing features, namely a bottom edge of the upper portion of the blade housing that protrudes on either end from the blade, and an end surface that is rounded and inclined upwardly and from either end of the bottom edge. It is further submitted that these additional elements of claim 12 render the invention patentable over the cited prior art.

**B. Rejection of Claim 12 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 12 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claims 1 and 11. In addition, there is no teaching or suggestion in any of these references of the invention of claim 1, including the feature of a co-extruded rail base/rail material made of, inter alia, PVC with 10% plasticizer, and additionally claiming the film cutter of claim 12 having the aforementioned blade housing features, namely a bottom edge of the upper portion of the blade housing that protrudes on either end from the blade, and an end surface that is rounded and inclined upwardly and from either end of the bottom edge. It is further submitted that these additional elements of claim 12 render the invention patentable over the cited prior art.

For the above reasons, claim 12 should be declared allowable.

**5. Claim 13 Should Be Declared Allowable**

Claim 13 depends from claim 11 with the additional element wherein the lower portion of the blade housing is formed of a tracking device for slidably moving in the channel.

**A. Rejection of Claim 13 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 13 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set

forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claims 1 and 11. In addition, there is no teaching or suggestion in any of these references of the invention of claim 1, including the feature of a co-extruded rail base/rail material made of, inter alia, PVC with 10% plasticizer, and additionally claiming the film cutter of claim 11 having the aforementioned rail channel, upper and lower portion blade housing that slides in the channel formed between the rails and, specifically with respect to claim 13, the additional element wherein the lower portion of the blade housing has a tracking device for sliding in the channel formed between the rails. It is thus further submitted that these additional elements of claim 13 render the invention patentable over the cited art.

**B. Rejection of Claim 13 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 13 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “**09741521MA**”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claims 1 and 11. In addition, there is no teaching in any of these references of the invention of claim 1, including the feature of a co-extruded rail base/rail material made of, inter alia, PVC with 10% plasticizer, and additionally claiming the film cutter of claim 11 having the aforementioned rail channel, upper and lower

portion blade housing that slides in the channel formed between the rails and, specifically with respect to claim 13, the additional element wherein the lower portion of the blade housing has a tracking device for sliding in the channel formed between the rails. It is thus further submitted that these additional elements of claim 13 render the invention patentable over the cited art.

For the above reasons, claim 13 should be declared allowable.

**6. Claim 14 Should Be Declared Allowable**

Claim 14 depends from claim 13 and adds the further elements that the tracking device of claim 13 is formed of a tubular base and the channel has a corresponding tubular shape. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

**A. Rejection of Claim 14 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 14 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claims 1, 11 and 13. In addition, there is no teaching in any of these references of the invention of claim 1, including the feature of a co-extruded rail base/rail material made of, inter alia, PVC with 10% plasticizer, and additionally claiming the film cutter of claim 11 having the aforementioned rail channel, upper and lower portion blade housing that slides in the channel formed between the rails and, with respect to

claim 13, the additional element wherein the lower portion of the blade housing has a tracking device for sliding in the channel formed between the rails, and, specifically with respect to claim 14, the still further feature of the tracking device such that the device is tubular and the channel has a corresponding tubular shape. It is thus further submitted that these additional elements of claim 14 render the invention patentable over the cited art.

**B. Rejection of Claim 14 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 14 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “**09741521MA**”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claims 1, 11 and 13. In addition, there is no teaching or suggestion in any of these references of the invention of claim 1, including the feature of a co-extruded rail base/rail material made of, inter alia, PVC with 10% plasticizer, and additionally claiming the film cutter of claim 11 having the aforementioned rail channel, upper and lower portion blade housing that slides in the channel formed between the rails and, with respect to claim 13, the additional element wherein the lower portion of the blade housing has a tracking device for sliding in the channel formed between the rails, and, specifically with respect to claim 14, the still further feature of the tracking device such that the device is tubular and the channel has a corresponding tubular shape. It is thus further submitted that these additional elements of claim 14 render the invention patentable over the cited art.

For the above reasons, claim 14 should be declared allowable.

**7. Claim 16 Should Be Declared Allowable**

Claim 16 depends from claim 1 with the further element wherein the blade housing is formed of acetal or silicon.

**A. Rejection of Claim 16 at Pages 9-10, ¶ 6 of the Action**

In the Action, at pages 9-10, ¶ 6, it is said that claim 16 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart** and further in view of **Urion**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, it is further submitted that there is no teaching or suggestion from a non-hindsight combination of the cited references to render claim 16 obvious in light of the additional element wherein the blade element is formed of acetal or silicon. It is thus further submitted that these additional features of claim 16 render the invention patentable over the cited art.

For the above reasons, claim 16 should be declared allowable.

**8. Claim 17 Should Be Declared Allowable**

Claim 17 depends from Claim 1 with the additional element wherein the film cutter apparatus of claim 1 comprises an adhesive layer adhered to the elongated rail base on a surface opposite of the rail(s).

**A. Rejection of Claim 17 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 17 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set



forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this rejection as applied to claim 1. In addition, there is no teaching in any of these references of the invention of claim 1, including the additional features of claim 17 wherein an adhesive layer is adhered to the elongated rail base on a surface opposite the rail(s). It is thus further submitted that these additional elements of claim 17 render the invention patentable over the cited art.

**B. Rejection of Claim 17 at Page 10, ¶ 7 of the Action**

In the Action at page 10, ¶17, it is said that claim 17 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart** as applied to claims 1, 5, 11-14, 20-23, 38-40, 42-44, and further in view of **Chiu**.

For the sake of brevity, applicants submit herein that this rejection is erroneous for the reasons set forth above with respect to this same rejection as applied to claims 1, 5, and 11-14, and below with respect to claims 20–23, 38–40 and 42-44, including to the extent it combines **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart**. With respect to this combination further in view of **Chiu**, it is submitted that the addition of **Chiu** to the combination is erroneous.

**Chiu** discloses a cutting device for a roll of film including a cutter placed on a positioning unit. A guide unit includes two vertical plates projecting downwardly from the rear portion of the cutter through the slot and two horizontal plates that project outwardly from the lower edge of the vertical plates. The length of the vertical plates is slightly longer than the thickness

of the top wall of the positioning unit so that the front portion of the sliding body can turn somewhat upwardly to facilitate cutting of the protective film by the cutting edge of the blade. (Col. 2, line 57 – Col. 3, line 5, Figures 3 and 4.) The positioning unit further includes an upright front stop plate which is mounted securely on the front end portions of the side and top walls of the positioning unit, and an upright rear stop plate which is mounted removably on the rear end portions of the side and top walls of the positioning unit so as to permit removal of the cutter from the positioning unit. (Col. 3, lines 6-57, Figures 3 and 4.)

In contrast to the invention defined by the present claims as noted above, **Chiu** does not teach or suggest rails being formed of a material providing an attraction to plastic wrap received over the rails to cling the plastic wrap to the rails before, during and after cutting of the plastic wrap. Further, **Chiu** does not teach or suggest that a blade is angled in a blade housing. Rather, **Chiu** uses the shape of the cutter to allow the sliding body to turn upward in order to prevent bunching of the film. Thus, **Chiu** does not add support to **Chuang**, **Lucas** and **Wankow**, as explained above.

Even assuming, arguendo, that the combination is proper, is further submitted that **Chiu** does not disclose an adhesive layer adhered to the elongated rail base on a surface opposite of the rails. The Action, at page 10, acknowledges that the means by which the **Chiu** rail assembly is mounted to a box is not disclosed, but takes “official notice” that one of ordinary skill in the art would assume that glue or adhesive is used. Applicants submit, however, that this assumption is not valid, as other means for mounting the device to a box could be used, such as a mechanical means and, since **Chiu** is silent on the issue, it is not appropriate to substitute an

assumption for an actual disclosure. It is further submitted that the additional elements of claim 17 render the invention patentable over the prior art.

For the above reasons, claim 17 should be declared allowable.

9. **Claim 18 Should Be Declared Allowable**

Claim 18 depends from claim 1 with the additional element wherein a channel is formed in the elongated rail base below a pair of rails and further comprising a protrusion extending in the channel, and at either end of said channel.

A. **Rejection of Claim 18 at Pages 11-12, ¶ 8 of the Action**

In the Action, at pages 11-12, ¶ 8, it is said that claim 18 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart**, and further in view of **Keane**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit herein that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1, 5, 11-14 and 17, including to the extent it combines **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart**. With respect to this combination further in view of **Keane**, it is submitted that the addition of **Keane** to the combination is erroneous.

**Keane** discloses an apparatus for severing a web. The lower portion of a shuttle is an elongated cylindrical member which may be tapered at either terminal portion to engage insert 46. Means are used to hold the film adjacent to surface 14. (Col. 2, lines 34-37).

In contrast to the invention defined by claim 18, **Keane** does not teach or suggest at least one rail being formed of a material providing cling properties to the plastic wrap received

over the rail for attracting the plastic wrap to the rail, and wherein the material is rubber, polyvinylchloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof. To the contrary, Keene uses rollers to hold plastic down. Accordingly, Keene is not properly combined with **Chuang** in view of **Lucas**, **Wankow**, the **Phthalate Reference**, and **Gearhart**.

Even assuming, arguendo, that the combination is proper, **Keene** does not help to render the invention of claim 18 obvious in light of the cited art. The Action, at page 11, acknowledges that **Chuang** does not disclose the additional features added to claim 1 by claim 18. However, with respect to **Keene**, the Action, at page 11, merely states that “there *could be considered* a protrusion 40 on the lower portion of the housing, and a receptacle inside the rail channel . . . Id.” (emphasis added). The Action goes on to speculate, without *any* objective evidence, that one of ordinary skill could “add one retention element to the lower portion of a blade housing in a rail style cutter, and a corresponding retention element to the side of the channel of the rail style cutter as taught by **Keene**, for the purpose of retaining a slide cutter at one end of a channel in a rail style cutter.” Id. at 11-12. In response, applicants respectfully submit that the Action has, in the guise of baldly stating what one of ordinary skill in the art could do, and without *any* objective evidence as to why , re-written **Keene**, and read subject matter into **Keene**, to justify the instant rejection. For this reason, and on the basis of well established patent law, the rejection of claim 18 is erroneous and should be reversed. It is further submitted that the additional elements of claim 18 render the invention patentable over the prior mat.

For the above reasons, claim 18 should be declared allowable.

**10. Claim 19 Should Be Declared Allowable**

Claim 19 depends from claim 18 (which depends from claim 1) wherein the claim 19 apparatus comprises the features wherein the blade housing is formed of an upper portion and a lower portion, the upper portion houses the blade, the lower portion slides in the channel, and wherein the lower portion of the blade housing snap fits into the protrusion.

**A. Rejection of Claim 19 at Pages 11-12, ¶ 8 of the Action**

In the Action, at pages 11-12, ¶ 8, it is said that claim 19 is obvious under 35 U.S.C. § 103(a) over **Chuang** in view of **Lucas, Wankow, the Phthalate Reference, and Gearhart**, and further in view of **Keane**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit herein that this rejection is erroneous for the reasons set forth above with respect to in response to this same rejection as applied to claim 18 as it combines **Chuang** in view of **Lucas, Wankow, the Phthalate Reference, Gearhart and Keane**. It is submitted that this rejection and the combination of the cited art is erroneous for the reasons set forth above with respect to claim 18. In addition, at page 11 of the Action, it is said that “**Chuang** does not disclose a protrusion in the channel, the lower portion of the blade housing ‘snap fits’ ‘into’ said protrusion.” (emphasis added) Applicants submit that this portion of the Action concerning claim 19 is confusing because it states that **Chuang** does not disclose a protrusion in a channel but that the blade housing snaps fit into a protrusion which is not disclosed. The Action provides no citation to **Chuang’s** specification or figures for this confusing statement. In any event, applicants submit, after a further review of **Chuang**, that the reference provides no disclosure of a lower portion of a blade housing of the instant invention

that “snap fits” into any protrusion of a channel. For these reasons, the rejection of claim 19 is erroneous and should be reversed. It is further submitted that the additional elements of claim 19 render the invention patentable over the prior art.

For the above reasons, claim 19 should be declared allowable.

**11. Claim 20 Should Be Declared Allowable**

In summary form, independent claim 20 is directed to a film cutter for cutting plastic wrap comprising at least one rail, a blade housing for housing a blade, and which is bilaterally slidable along the rail. The blade is angled from a bottom edge of the blade. A portion of the rail is made of a material that provides an attractive cling to the plastic wrap received over the rail for attracting the wrap to the rail and clinging the wrap to the rail before, during and after the cutting of the wrap. Also, a portion of the rail material of the rail is selected from the group consisting of plastic, rubber, polyvinyl chloride wherein the PVC comprises at least 10 percent plasticizer, silicon elastimer and combinations thereof.

**A. Rejection of Claim 20 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 20 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit herein that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1, in particular the erroneous combination of the **Lucas** (a slide cutter) and **Wankow** (a fixed blade box carton), together with the supporting disclosures of **Boda**, **Urion**, and **Tsai**. And, specifically, as pointed

out by applicants with respect to this rejection as applied to claim 1, even if, arguendo, **Lucas** and **Wankow** can be properly combined, such combination would still fall short of making out a case of the obviousness of claim 1. As acknowledged in the Action, at page 6, **Lucas** does not disclose “polyvinyl chloride comprising at least 10% plasticizer,” and, at page 7 of the Action, “**Lucas** in view of **Wankow** does not disclose that the plasticizer exceeds least 10%.” Rather, it is said that **Lucas** suggests the use of a urethane tape or coating. See Action, pages 6-7. And, the Action states, at pages 6-7, that **Wankow** discloses vinyl (not polyvinyl) chloride which, as discussed above, comprises dots on the side of the **Wankow** fixed blade box carton and are not used in cutting.

Further, neither **Lucas** nor **Wankow** teach or suggest a rail formed of a material for providing attraction to plastic wrap received over a rail for clinging the plastic wrap to the rail “before, during and after cutting.” Specifically, there is no teaching or suggestion in **Wankow** to modify a rail cutter to integrate plasticizer that provides cling attraction to the film to be cut in this manner. **Lucas** merely discloses, at best, a non-slip surface formed of urethane tape which is said to be adhered a surface of a guide. See **Lucas**, Col 1, lines 1-17.

Thus, this combination of the prior art falls far short of rendering the invention of claim 20 as a whole, and, in particular, the aspects of the claimed invention which comprise a portion of a cutting rail that includes, inter alia, a PVC/at least 10% plasticizer combination that results in the clinging of the plastic wrap “before, during and after cutting.” It is further submitted that these additional elements of claim 20 render the invention patentable over the prior art.

**B. Rejection of Claim 20 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 20 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “09741521MA”) in view **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, as stated above, this combination of the prior art falls far short of rendering the invention of claim 20 as a whole, and, in particular, the aspects of the claimed invention which comprise a portion of a cutting rail that includes, inter alia, a PVC/at least 10% plasticizer combination that results in the clinging of the plastic wrap “**before, during and after cutting.**” It is further submitted that these additional elements of claim 20 render the invention patentable over the prior art.

For the above reasons, claim 20 should be declared allowable.

**12. Claim 21 Should Be Declared Allowable**

In summary form, independent claim 21 is directed to a film cutter apparatus for cutting plastic wrap comprising at least one rail, a blade housing for housing a blade and which bilaterally slides along a rail. The blade is angled from a bottom edge of the blade. In addition, a portion of the rail is formed of a first material which provides cling properties to plastic wrap received over the rail for attracting the plastic wrap to the rail and holding the wrap to the rail before, during and after cutting of the wrap. Further, an adhesive layer is adhered to an elongated rail base on a surface opposite of the rail, and the first material is selected from the



group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof.

**A. Rejection of Claim 21 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 21 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 20. In particular, as addressed above, applicants submit that none of the cited references disclose, alone or in combination, the use of PVC comprising 10% plasticizer over the rails to ensure that the plastic wrap clings to said rails before, during and after cutting of said plastic wrap. In addition, there is no teaching in any of these references of the invention of claim 21, including the additional features of claim 21 wherein there is an adhesive layer adhered to the elongated rail base on a surface opposite the rail(s), and the Action does not point out any such disclosure in the cited art. It is thus further submitted that these additional elements of claim 21 render the invention patentable over the cited art.

**B. Rejection of Claim 21 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 21 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as "**09741521MA**") in view of **Lucas**, in view of

**Wankow, the Phthalate Reference, and Gearhart.** The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 20. In addition, as stated above, there is no teaching in any of these references of the invention of claim 21, including the additional features of claim 21 wherein there is an adhesive layer adhered to the elongated rail base on a surface opposite the rail(s), and the Action does not point out any such disclosure in the cited art. It is thus further submitted that these additional elements of claim 21 render the invention patentable over the cited art.

For the above reasons, claim 21 should be declared allowable.

**13. Claim 22 Should Be Declared Allowable**

Independent claim 22 is directed to a film cutter apparatus for cutting plastic wrap comprising an elongated rail base, a pair of rails formed at a top surface of said elongated rail base, a blade housing for housing a blade, and which is bilaterally slidable along the rails. The blade is angled from a bottom edge of the blade. A portion of the rails are formed of a first material which provides cling properties to plastic wrap received over the rails for attracting the plastic wrap to the rails and holding the wrap to the rails before, during and after cutting of said plastic wrap. The first rail material is selected from the group consisting of plastic, rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof, and wherein the elongated rail base is formed of a second material of rigid PVC, and first material is coextruded with said second material.

**A. Rejection of Claim 22 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 22 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1, 20 and 21. In particular, as discussed with respect to claim 1, it is reiterated that none of the references cited with respect to this rejection teach or disclose the co-extrusion of the described rail base and rail to provide an integrated structure having the varied properties of rigidity, support and adhesion of the film to be cut. At page 4 of the July 3, 2007 Action incorporated in this rejection, it is stated that co-extrusion is well known in the manufacturing of polymers and “does not further limit the structure,” pointing to **Boda** and **Lucas**. Applicants, however, respectfully submit that this is a red herring argument. Neither **Boda** nor **Lucas** disclose a co-extruded rail structure. All that this portion of the July 3, 2007 Action stands for is that co-extrusion, as a general manufacturing process, can be applied in numerous contexts and does nothing to advance the disclosures or teachings of the relevant rail-based film cutter art with which this claim is specifically concerned. It is further submitted that the additional elements of this claim render the invention patentable over the prior art.

**B. Rejection of Claim 22 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 22 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending

case 09/741,521, entered into the record as “09741521MA”) in view of Lucas, in view of Wankow, the Phthalate Reference, and Gearhart. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1, 20 and 21 and for the reasons set forth in point 13A. above. It is further submitted that the additional elements of this claim render the invention patentable over the prior art.

For the above reasons, claim 22 should be declared allowable.

**14. Claim 23 Should Be Declared Allowable**

Independent claim 23 is directed to a film cutter apparatus for cutting plastic wrap comprising an elongated rail base and a pair of rails formed at a top surface of the rail base. A portion of the rails are formed of a first material which provides cling properties to plastic wrap received over the rails for attracting the wrap to the rails and holding the wrap to the rails before, during and after cutting of the wrap. The first material is selected from the group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof. In addition, the invention includes a blade housing for housing a blade, and which bilaterally slides along the rails. The blade housing is formed of an upper portion and a lower portion, the upper portion of the blade housing houses the blade, the lower portion of the blade housing slides in the channel. The blade is angled from its bottom edge. The elongated rail base is formed of a second material of rigid PVC, and the first material is coextruded with the second material.

**A. Rejection of Claim 23 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 23 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1, 11, 20, 21 and 22. And, in particular, applicants submit that none of the cited references, particularly **Lucas** in view of **Wankow**, are properly combined to teach or disclose the film cutter of claim 23 as a whole, including, with respect to the additional features of this claim, namely, a film cutter described in this claim together with a blade housing for housing a blade, which bilaterally slides along the rails, and which is formed of an upper portion and a lower portion, wherein the upper portion of the blade housing houses the blade, the lower portion of the blade housing slides in the channel, and the blade is angled from its bottom edge. It is further submitted that these additional elements of claim 23 render the claimed invention patentable over the prior art.

**B. Rejection of Claim 23 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 23 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1, 11, 20, 21 and 22.

And, in particular, applicants submit that none of the cited references, i.e., **Chuang**, the artifact “**09741521MA**”, in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**, are properly combined to teach or disclose the film cutter of claim 23 as a whole, including, with respect to the additional features of this claim, namely, a film cutter described in this claim together with a blade housing for housing a blade, which bilaterally slides along the rails, and which is formed of an upper portion and a lower portion, wherein the upper portion of the blade housing houses the blade, the lower portion of the blade housing slides in the channel, and the blade is angled from its bottom edge. It is further submitted that these additional elements of claim 23 render the claimed invention patentable over the prior art.

For the above reasons, claim 23 should be declared allowable.

**15. Claim 38 Should Be Declared Allowable**

In summary, independent claim 38 is directed to a method of forming a film cutter apparatus comprising, molding an elongated rail base and molding a pair of rails, attaching the rails at a top surface of the elongated rail base, wherein a portion of the rails is formed of a material having clinging properties for attracting film to the rails and holding the film to the rails before, during and after cutting of the film.

**A. Rejection of Claim 38 at Pages 3-9, ¶ 5 of the Action**

In the Action it is said, at pages 3-9, ¶ 5, that claim 38 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “**09741521MA**”) in view of **Lucas**, in view of **Wankow**,

the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, applicants submit that none of the cited references disclose, alone or in combination, the molding of a rail base and a pair of rails, and attaching the dual rails to the top of the rail base, wherein a portion of the rails are formed of a material having cling properties for attracting film to the rails and holds the film to the rails before, during and after cutting of the film. Indeed, while the Action rejects this claim over the cited art, it cites no portion of any of the art which in fact discloses the method of claim 38.

For the above reasons, claim 38 should be declared allowable.

**16. Claim 39 Should Be Declared Allowable**

In summary form, claim 38 depends from claim 39 with the additional element wherein the step of molding the elongated rail base and the step of molding a pair of rails are performed simultaneously by coextrusion for attaching said rails to said elongated rail base.

**A. Rejection of Claim 39 at Pages 3-9, ¶ 5 of the Action**

In the Action it is said, at pages 3-9, ¶ 5, that claim 39 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 38. In addition, similar to that discussed above with respect to this rejection as applied to claim 1, the cited art, either alone or in combination, does not disclose a method of forming of an integrated rail base/rail by simultaneous co-extrusion, and, the Action points to no art containing the disclosure of this method.

Moreover, similar to that discussed above with respect to claim 1, this rejection is based upon an expanded combination that depends, with respect to the additional element of this claim, entirely on **Gearhart**. See Action, pages 7-8. However, **Gearhart** generally teaches co-extrusion of PVC to bond a capstock material and is not directed to the film cutting art. See Col. 1, line 54-Col. 2, line 33. Neither **Gearhart**, nor any of the other cited art, is directed in any way to the art of constructing integrated, multiple material, rail-style film cutters using simultaneous co-extrusion molding.

In addition, it is submitted that these additional elements of simultaneous molding of a rail base and rail cutters by coextrusion further advances the patentability of the claimed invention over the prior art.

For the above reasons, claim 39 should be declared allowable.

**17. Claim 40 Should Be Declared Allowable**

Independent claim 40 is directed to a method for cutting a plastic wrap comprising, an elongated rail base, receiving the plastic wrap over at least one rail formed at a top surface of the rail base, and clinging the plastic wrap to a rail. At least one rail is formed of a material which provides cling properties to the received plastic wrap for cling of the wrap to the rails, so



as to facilitate the holding and cutting of the wrap with a blade. The blade is housed in a blade housing, which bilaterally slides along the rail, and the plastic wrap clings to said rails before, during and after cutting of said plastic wrap.

**A. Rejection of Claim 40 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 40 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, applicants submit that none of the cited references disclose in proper combination, namely **Lucas** and **Wankow**, the claimed method wherein the plastic wrap clings to said rails before, during and after cutting of said plastic wrap.

**B. Rejection of Claim 40 at Pages 3-9, ¶ 5 of the Action**

Further, in the Action it is said, at pages 3-9, ¶ 5, that claim 40 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “09741521MA”) in view **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claim 1. In addition, applicants submit that none of the cited references in combination teach the method of claim 40.

Specifically, the Action, at pages 4-5, cites a model of **Chuang**, artifact **09741521MA**, as capable of attracting plastic wrap over rails both before, during and after cutting of said plastic wrap. However, as stated above with respect to this rejection as applied to claim 1, **Chuang** discloses a slidable plastic film cutter with a push button having rollers disposed upon the bottom surface of the push button cutting means. The push button/roller combination is said to inhibit the plastic film from gathering at the bottom of the cutter blade because the film is pressed and pulled tightly during the cutting operation. See Chuang, Col. 2, lines 1-14; Figures 3C and 3D. The ability of **Chuang**, and the artifact **09741521MA**, to adhere film while cutting is due to their “push button” roller means, not cling properties.

For the above reasons, claim 40 should be declared allowable.

**18. Claim 42 Should Be Declared Allowable**

Claim 42 depends from independent claim 40 with the additional element wherein said first rail material is non-porous.

**A. Rejection of Claim 42 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 42 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 40. In addition, applicants submit that none of the cited references disclose, alone or in combination, a first material which is non-porous. Further it is submitted that the additional element wherein the

first rail material comprised of a non-porous material further renders the invention patentable over the cited art.

**B. Rejection of Claim 42 at Pages 3-9, ¶ 5 of the Action**

In the Action it is said, at pages 3-9, ¶ 5, that claim 42 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “**09741521MA**”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 40. In addition, applicants submit that none of the cited references disclose, alone or in combination, a first material which is non-porous. Further it is submitted that the additional element wherein the first rail material comprised of a non-porous material further renders the invention patentable over the cited art.

For the above reasons, claim 42 should be declared allowable.

**19. Claim 43 Should Be Declared Allowable**

Claim 43 depends from claim 40 and further recites the additional element wherein the first material forming the rail is smooth.

**A. Rejection of Claim 43 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 43 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set

forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 40. In addition, applicants submit that none of the cited references disclose, alone or in combination, a first material which is smooth. Further it is submitted that the additional element wherein the first rail material is comprised of a smooth material, and yet provides cling properties, further renders the invention patentable over the cited art.

**B. Rejection of Claim 43 at Pages 3-9, ¶ 5 of the Action**

In the Action it is said, at pages 3-9, ¶ 5, that claim 43 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “**09741521MA**”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 40. In addition, applicants submit that none of the cited references disclose, alone or in combination, a first material which is smooth. Further it is submitted that the additional element wherein the first rail material is comprised of a smooth material, and yet provides cling properties, further renders the invention patentable over the cited art.

For the above reasons, claim 43 should be declared allowable.

**20. Claim 44 Should Be Declared Allowable**

Claim 44 depends from independent claim 40 with the additional element wherein the first material is selected from the group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof.

**A. Rejection of Claim 44 at Page 3, ¶ 4 of the Action**

In the Action, it is said at page 3, ¶ 4, that claim 44 is obvious under 35 U.S.C. § 103(a) over **Lucas**, in view of **Wankow**, with supporting evidence from **Boda**, **Urion**, and **Tsai** as set forth in a prior action dated July 3, 2007. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 40. In addition, applicants submit that none of the cited references disclose, alone or in combination, a method of cutting film by using a rail utilizing, inter alia, PVC comprising 10% plasticizer, which ensures that the plastic wrap clings to said rails before, during and after cutting of said plastic wrap. Further, it is submitted that these additional elements further render the invention patentable over the cited art.

**B. Rejection of Claim 44 at Pages 3-9, ¶ 5 of the Action**

In the Action it is said, at pages 3-9, ¶ 5, that claim 44 is obvious under 35 U.S.C. § 103(a) over **Chuang** (and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record as “09741521MA”) in view of **Lucas**, in view of **Wankow**, the **Phthalate Reference**, and **Gearhart**. The applicants submit that this rejection is erroneous and should be reversed for the following reasons.

For the sake of brevity, applicants submit that this rejection is erroneous for the reasons set forth above in response to this same rejection as applied to claims 1 and 40. In addition, applicants submit that none of the cited references disclose, alone or in combination, a method of cutting film by using a rail utilizing, inter alia, PVC comprising 10% plasticizer, which ensures that the plastic wrap clings to said rails before, during and after cutting of said plastic wrap. Further, it is submitted that these additional elements further render the invention patentable over the cited art.

For the above reasons, claim 44 should be declared allowable.

**The Objective Evidence Of The Commercial Success And Copying Of The Claimed Invention Demonstrates That The Claims On Appeal Are Allowable**

The Action, at pages 15-20, has rejected all of the claims on appeal despite applicants' strong showing of commercial success and copying of the claimed invention as is demonstrated in the **Vegliante Decl.** (Exhibit 2) and the **Supp. Vegliante Decl.** (Exhibit 3).

In summary, the Action states that there is an insufficient showing in applicants' evidence of a nexus between the commercial success of the claimed invention and the features of the invention. See Action, pages 15-16 and 19. In particular, the Action states that "[p]erhaps all of the sales were based on price, shipping times, customer service" or some other factor except the features of the invention. Action at page 16 (emphasis added.)

Applicants respectfully submit that the Action set too high a bar for demonstrating commercial success, and discounted the strong sales and market penetration of the claimed invention by engaging, in part, on mere conjecture, despite the fact, as stated in the Declarations, that the success of the claimed invention was achieved without any advertising or promotion. **Vegliante Decl.**, pages 16-17, ¶¶ 19-21.

### *Commercial Success*

As shown in the **Vegliante Decl.**, which amply demonstrates great commercial success, *without any advertising of the claimed invention*, “an important feature highly appreciated by the customers and users is the functioning of the slide cutter product based on the cling of the plastic wrap to the cutter to enable the plastic wrap to be held in place before, after and during the cutting of the plastic wrap.” See **Vegliante Decl.** page 6-17, ¶¶ 19-21 (emphasis added.). Thus, the commercial success of the product is tied to the heart of the invention as claimed.

In the **Supp. Vegliante Decl.**, applicants submitted more detailed evidence that cannot be disputed as being totally objective on the issue of commercial success. In particular, applicants demonstrated, through the **Supp. Vegliante Decl.**, at pages 3-4 thereof, and the Plastic Wrap Market Report (“PWMR”), an entirely independent study of the relevant plastic wrap and cutter market (Exhibit G to the **Supp. Vegliante Decl.**), that there is no credible dispute that (1) AEP’s, [applicants’ assignee], slide film cutter was a huge commercial success, and (2) the commercial AEP slide cutter is what is covered by at least independent claim 1 of the instant application. In addition, the PWMR demonstrates that by 2005, AEP’s slide cutter penetrated 25 percent of a market dominated by huge and long-established competitors. Moreover, and importantly, AEP’s high sales (on the order of 30-70 million) of its cutter have been made without any advertising and promotion. Those sales were due to the slide cutter claimed in the instant application. Thus, on the basis of this evidence alone, and as a matter of both law and fact, applicants’ have made a *prima facie* case of commercial success and a nexus between that success and the claimed invention. **Supp. Vegliante Decl.**, pages 3-4, ¶¶ 4-10.

In addition, patent applications for the slide cutter of the instant invention have been granted in Canada, Australia and New Zealand, the only foreign countries where such applications were filed. Id. at page 4, ¶ 11.

#### *Copying*

In addition to the high commercial success of the claimed invention as set forth in the **Vegliante Decl.** and the **Supp. Vegliante Decl.**, the applicants have also demonstrated with the support of those declarations and the exhibits thereto that the claimed invention has been the subject of wide-spread copying. In summary, the slide cutter of the instant application was and is the subject of worldwide copying which is a fact that, standing almost alone, can be determinative of non-obviousness. Advanced Display Systems, Inc. v. Kent State University, 212 F.3d 1272, 1285, 54 U.S.P.Q. 2d 1673, 1682 (Fed. Cir. 2000)(wholesale copying provides “compelling evidence” of nonobviousness). The Vegliante Declarations and the Exhibits thereto point to a litany of copiers of the instant invention; just to name a few:

- Reynolds Company
- Anchor Wrap Packaging
- Diamant Films Inc.
- Pliant Corporation
- Polyvinyl Company
- Metal Edge International, Inc.
- Durable Packaging International

**Supp. Vegliante Decl.**, pages 4-5, ¶¶ 13-19.



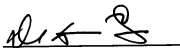
It is therefore respectfully submitted that the great weight of the objective evidence on commercial success and copying further demonstrates that the claims of the instant application are patentable under 35 U.S.C. § 103(a).

**CONCLUSION**

For the reasons set forth above, applicants submit that the rejections of the claims subject to this appeal are erroneous and should be reversed and that all claims subject to this Appeal be declared allowable.

Dated: August 16, 2010

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Diane Dunn McKay', is written over a horizontal line.

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VIII. CLAIMS APPENDIX

1. (Previously presented) A film cutter apparatus for cutting plastic wrap comprising:

an elongated rail base;

at least one rail formed at a top surface of said elongated rail base;

a blade housing for housing a blade, said blade housing bilaterally slidable along said at least one rail, said blade is angled from a bottom edge of said blade; and

a portion of said at least one rail being formed of a first material which provides cling properties to said plastic wrap received over said at least one rail for attracting said plastic wrap to said at least one rail and holding said plastic wrap to said at least one rail before, during and after cutting of said plastic wrap,

wherein said first material is selected from the group consisting of, rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof, wherein said elongated rail base is formed of a second material of rigid PVC, said first material is coextruded with said second material.

2. (Canceled).

3. (Canceled).

4. (Canceled).

5. (Original) The apparatus of claim 1 wherein said first material is smooth.

6. (Canceled).

7. (Canceled).

8. (Canceled).

9. (Canceled).

10. (Canceled).

11. (Previously presented) The apparatus of claim 1 wherein a channel is formed in said elongated rail base below a pair of said at least one rail, said blade housing being formed of an upper portion and a lower portion, said upper portion of said blade housing houses said blade, and said lower portion of said blade housing slidably moving in said channel.

12. (Original) The apparatus of claim 11 wherein a bottom edge of said upper portion of said blade housing protrudes on either end from said blade and an end surface of said upper portion of said blade housing being rounded and inclined upwardly and from either end of said bottom edge.

13. (Original) The apparatus of claim 11 wherein said lower portion is formed of a tracking device for slidably moving in said channel.

14. (Original) The apparatus of claim 13 wherein said tracking device is formed of a tubular base and said channel having a corresponding tubular shape.

15. (Canceled).

16. (Previously presented) The apparatus of claim 1 wherein said blade housing is formed of acetal or silicon.

17. (Previously presented) The apparatus of claim 1 further comprising an adhesive layer adhered to said elongated rail base on a surface opposite of said at least one rail.

18. (Original) The apparatus of claim 1 wherein a channel is formed in said elongated rail base below a pair of said at least one rail and further comprising a protrusion extending in said channel at either end of said channel.

19. (Previously presented) The apparatus of claim 18 wherein said blade housing is formed of an upper portion and a lower portion, said upper portion of said blade housing houses said blade, said lower portion of said blade housing slidably moving in said channel, wherein said lower portion of said blade housing snap fits into said protrusion.

20. (Previously presented) A film cutter apparatus for cutting plastic wrap comprising:

at least one rail;

a blade housing for housing a blade, said blade housing bilaterally slidable along said at least one rail, said blade is angled from a bottom edge of said blade; and

a portion of said at least one rail being formed of a first material which provides an attractive cling to plastic wrap received over said at least one rail for attracting said plastic wrap to said at least one rail and clinging said plastic wrap to said at least one rail before, during and after cutting of said plastic wrap,

wherein said first material is selected from the group consisting of plastic, rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof.

21. (Previously presented) A film cutter apparatus for cutting plastic wrap comprising:

- at least one rail;

- a blade housing for housing a blade, said blade housing bilaterally slidable along said at least one rail, said blade is angled from a bottom edge of said blade;

- a portion of said at least one rail being formed of a first material which provides cling properties to plastic wrap received over said at least one rail for attracting said plastic wrap to said at least one rail and holding said plastic wrap to said at least one rail before, during and after cutting of said plastic wrap; and

- an adhesive layer adhered to said elongated rail base on a surface opposite of said at least one rail,

wherein said first material is selected from the group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof.

22. (Previously presented) A film cutter apparatus for cutting plastic wrap comprising:

- an elongated rail base;

- a pair of rails formed at a top surface of said elongated rail base;

- a blade housing for housing a blade, said blade housing bilaterally slidable along said rails, said blade is angled from a bottom edge of said blade; and

- a portion of said rails being formed of a first material which provides cling properties to plastic wrap received over said rails for attracting said plastic wrap to said rails and holding said plastic wrap to said rails before, during and after cutting of said plastic wrap,

wherein said first material is selected from the group consisting of plastic, rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer

and combinations thereof, wherein said elongated rail base is formed of a second material of rigid PVC, said first material is coextruded with said second material.

23. (Previously presented) A film cutter apparatus for cutting plastic wrap comprising:

- an elongated rail base;

- a pair of rails formed at a top surface of said elongated rail base;

- a portion of said rails being formed of a first material which provides cling properties to plastic wrap received over said rails for attracting plastic wrap to said rails and holding said plastic wrap to said rails before, during and after cutting of said plastic wrap, wherein said first material is selected from the group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof; and

- a blade housing for housing a blade, said blade housing bilaterally slidable along said rails, said blade housing is formed of an upper portion and a lower portion, said upper portion of said blade housing houses said blade, said lower portion of said blade housing slidably moving in said channel, said blade is angled from a bottom edge of said blade wherein said elongated rail base is formed of a second material of rigid PVC, said first material is coextruded with said second material.

24. (Canceled).

25. (Canceled).

26. (Canceled).

27. (Canceled).

28. (Canceled).

29. (Canceled).

30. (Canceled).

31. (Canceled).

32. (Canceled).

33. (Canceled).

34. (Canceled).

35. (Canceled).

36. (Canceled).

37. (Canceled).

38. (Previously presented) A method of forming a film cutter apparatus comprising:  
molding an elongated rail base;  
molding a pair of rails;

attaching said rails at a top surface of said elongated rail base, wherein a portion of said rails being formed of a material having cling properties for attracting film to said rails and holding said film to said rails before, during and after cutting of said film.

39. (Previously presented) The method of claim 38 wherein said step of molding an elongated rail base and said step of molding a pair of rails are performed simultaneously by coextrusion for attaching said rails to said elongated rail base.

40. (Previously presented) A method for cutting a plastic wrap comprising:  
an elongated rail base;

receiving said plastic wrap over at least one rail formed at a top surface of an elongated rail base;

clinging said plastic wrap to said at least one rail; said at least one rail is formed of a material which provides cling properties to said received plastic wrap for cling of said plastic wrap to said rails;

cutting said plastic wrap with a blade, said blade being housed in a blade housing, said blade housing being bilaterally slidable along said at least one rail wherein said plastic wrap clings to said rails before, during and after cutting of said plastic wrap.

41. (Canceled).

42. (Previously presented) The method of claim 40 wherein said first material is non-porous.

43. (Previously presented) The method of claim 40 wherein said first material is smooth.

44. (Previously presented) The method of claim 40 wherein said first material is selected from the group consisting of rubber, polyvinyl chloride, said polyvinyl chloride comprising at least 10% plasticizer, silicon elastimer and combinations thereof.

IX. EVIDENCE APPENDIX

The following exhibits are relied upon by applicants in connection with this appeal:

Exhibit Nos:

1. Page 8 of an article cited in the Notice of References Cited, PTO Form 892, attached to Official Office Action mailed October 1, 2008, entitled “Phthalate Ester Plasticizers – Why and How They Are Used.” P.R. Graham, Environmental Health Perspectives, Vol. 3, (Jan., 1973), pp. 8, Published by: The National Institute of Environmental Health Sciences (NIEHS) (“**Phthalate Reference**”). The **Phthalate Reference** was entered into the record in the Notice of References Cited and the Official office Action mailed and entered in PAIR on October 1, 2008.
2. Declaration of Paul Vegliante submitted under 37 CFR 1.132, dated July 23, 2008 with exhibits A-F thereto. (“**Vegliante Decl.**”). The **Vegliante Decl.** was entered into the record in PAIR on July 25, 2008.
3. Supplemental Declaration of Paul Vegliante Submitted Under 37 CFR 1.132, dated December 9, 2009, with exhibits G-N thereto. (“**Supp. Vegliante Decl.**”). The **Supp. Vegliante Decl.** was entered into the record in PAIR on December 11, 2009.

X. RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a Court or the Board in any related proceeding or any proceeding identified pursuant to 37 C.F.R. § 41.37(c)(1)(ii).